

REMARKS

The Final Office action dated October 20, 2010 is acknowledged. According to the Final Office action, claims 1-20 are pending in the application, claims 5-8, 11 and 15 have been withdrawn and claims 1-4, 9, 10, 12-14 and 16-20 have been rejected. By the present response, claim 17 has been amended for purposes of clarification, with support found in the specification at paragraph [000048]. Reconsideration is respectfully requested in light of the amendments being made hereby and the arguments made herein. No new matter has been added.

Rejection of claims 17 and 19 under U.S.C. 112, first and second paragraph

The Examiner has rejected claims 17 and 19 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement in that the claims allegedly contain subject matter which was not described in the specification as to convey to one skilled in the relevant art that the inventor had possession of the claimed invention at the time the application was filed. Specifically, the Examiner states that claim 17 recites “skin has chromatic values” (with reference to paragraph [000048] of the specification for support). However, the Examiner states that the citation does not support claim 17. The Examiner also states that claim 19 recites “dyes and pigments is incorporated in the backing” (with reference to paragraph [000022] of the specification for support). However, the Examiner states that the citation does not support claim 19.

As noted above, claim 17 has been amended for purposes of clarification. In particular, the term “chromatic values” has been clarified to read “numerical values” as supported by the L,a,b system known in the art and set forth in paragraph [000048] of the

specification. Reference is made to paragraphs [000046] – [000048] of the specification which clearly support “numerical values.” Withdrawal of this rejection is thus requested.

Regarding claim 19, the Applicant also respectfully disagrees with the Examiner’s conclusion. Paragraph [000022] of the specification recites “optical masking is achieved by providing the ... backing layer with a content of at least one substance selected from the group of dyes and pigments.” The expression “providing the backing layer with a content of ...” clearly indicates to one skilled in the art that the substance is incorporated into the backing layer, such that it becomes a content of the backing layer. The second sentence of paragraph [000022] relates to a particular embodiment (i.e., “This can be accomplished, *in particular*,...” (emphasis added)). Therefore, the Applicant respectfully disagrees with the Examiner’s assertion in the Final Office action (at Section 3, page 3) that “this paragraph teaches coating with the pigment, and not incorporation in general.” Withdrawal of this rejection is also requested.

In view of the above, withdrawal of the rejection under 35 U.S.C. Section 112, first paragraph is appropriate.

Rejection of claims 1-4, 9-10, 12-14 and 16-20 under 35 U.S.C. 102(b)

Claims 1-4, 9-10, 12-14 and 16-20 have been rejected under 35 U.S.C. 102(b) as being anticipated by DE 10053375 (Degen, et al.). The Examiner states in the Final Office action that Degen, et al. disclose a transparent transdermal therapeutic system (TTS) that contains photosensitive active ingredient and that the TTS comprises colorless active ingredients contained in the polymer matrix and has a backing layer. As explained in the Final Office action, the Examiner concludes that Degen, et al. teach every

limitation of present claims 1-4, 9-10, 12-14 and 16-20 and thus anticipates the presently claimed invention.

The Applicant respectfully disagrees with the Examiner's conclusion and submit that the present invention as defined in the present claims is patentably distinct from the teachings of the prior art Degen, et al. reference. The also Examiner states in the Final Office action (page 5, lines 1-2) that "UV absorbers disclosed by the reference read on dyes or pigments since all of them have color (white)." The Applicant disagrees with this position as well. It is respectfully submitted that the fact that a substance has a color is not sufficient for qualifying it as a dye or pigment. Any substance, at least when present in solid or powdered form, has some "color" otherwise it would be invisible. However, it is also known to those skilled in the art that not all substances are thus suitable as dyes or pigments.

The Examiner has also referred to 4-amino benzoic acid which is described by Degen, et al. as a UV-absorbing, colourless substance. Since this substance absorbs only UV, it appears colourless to the human eye. The Examiner has further referred to an encyclopedia article in which this substance is described as having the appearance of "white crystals." However, it must be pointed out that these crystals are "white" due to the same reasons as snow is white (i.e., frozen water, which is also colourless) or baking soda is white. The white appearance is due to the reflection properties of the crystals. Although snow has the appearance of "white crystals, it is obvious that it cannot be used as a dye or pigment. Likewise, substances such as baking salt or common sugar, which

also have the appearance of white crystals, are not regarded as dyes or pigments by anyone skilled in the art.

In this regard, the Examiner has pointed out (at page 7 of the Final Office action) that “Applicant admits that the UV absorbers taught by the reference are white in color.” The Applicant further submits that this statement should be clarified in that the UV absorbers as taught by the Degen, et al. reference simply have a white appearance when present in crystalline form rather than a white “color.” It would nevertheless be clear to one skilled in the art that this “white appearance” in no way qualifies these UV absorbers as dyes or pigments, for the reasons set forth above.

With respect to the limitation “pigment,” the Examiner suggests in the Final Office action (page 8) that “pigment can be black or white and Degen, et al. teach UV absorbers that are known to be white.” However, neither Degen, et al. nor any other prior art of record, teach that the colorless UV absorbers of Degen, et al. are suitable as pigments. As discussed above, the fact that a substance may have a white appearance when it is in a crystalline state is not sufficient to render the substance as a pigment. Thus, the Applicant respectfully disagrees with the Examiner’s assertion (page 8 of the Final Office action) that “the presence of color is implied by Degen, et al. for teaching presence of UV absorber that are white in color.” The UV absorbers are not “white in color” but merely have a white appearance when present as crystals. Moreover, Degen, et al. fail to teach crystals at all.

In this connection, the Examiner refers to a definition by “Merriam-Webster Dictionary” which defines a pigment as “a substance that imparts black or white or a color to other materials.” However, with regard to the colourless substances of Degen, et al., it remains unknown whether or not these substances are capable of *imparting* “white” to other materials. One skilled in the art would be aware of the fact that while there is an immense number of substances that have a white or coloured appearance, only a limited number of these substances is suitable to be used as a dye or pigment.

Still further, the Examiner indicates that the recitation of “preferably colorless-transparent” in the Degen, et al. reference implies the presence of color. The Applicant disagrees since this conclusion cannot be justified while considering the context. In the introductory section, it is stated that “aluminized, coated or *dyed* covering films” are considered disadvantageous (“covering film” corresponds to “backing layer”). Therefore, the term “colorless-transparent” does not imply the presence of color. The purpose of claim 3 of the reference is probably to emphasize the fact that the backing layer is transparent.

In conclusion, it is submitted that Degen, et al. fail to teach each and every limitation of the present claims, and therefore the reference fails to anticipate the present invention as set forth in the present claims. Withdrawal of this rejection is strongly requested.

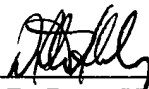
Conclusion

For the foregoing reasons, it is believed that the present application, as amended,

is in condition for allowance, and such action is earnestly solicited. Based on the foregoing arguments, amendments to the claims and deficiencies of the prior art references, the Applicant strongly urges that the anticipation and obviousness-type rejections be withdrawn. The Examiner is invited to call the undersigned if there are any remaining issues to be discussed which could expedite the prosecution of the present application.

Respectfully submitted,

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By: 
D. Peter Hochberg
Reg. No. 24,603

D. Peter Hochberg Co., L.P.A.
1940 E. 6th Street – 6th Floor
Cleveland, OH 44114
(216) 771-3800
DPH/SM